REMARKS

This paper is responsive to the *final* Office action, mailed January 7, 2008. Claims 1-24 were examined and rejected. Although the Office action purports to reject claims 25-33, no substantive basis for rejection appears in the action. Claims 34 and 35 were restricted under MPEP 821.03 and withdrawn from consideration. This response **cancels** the withdrawn claims without prejudice or disclaimer. Various claims have been amended to improve clarity and/or correct informalities. New dependent claims 36-38 are added.

Interview Summary

Applicant appreciates the time taken by Examiner Schmidt for a telephone conference with the undersigned on April 24, 2008. During that telephone conference, the following items were briefly discussed:

(1) Applicant noted that Section 102 rejections of claim 1 *et seq* (over *Schutzman*) appear to ignore limitations related to:

   a. sender policy authority (as contrasted with any recipient-centric rules in *Schutzman*);

   b. specific definitional limitations for "delivery" that appear in the text of the claim(s) and are clearly distinguishable from *Schutzman*; and

   c. order of operations: Even ignoring the specificity with which "delivery" is recited, the claim requires that policy determination be made before such delivery. Rule evaluation in *Schutzman* clearly follows any delivery.

(2) Applicant noted that claims 25-33 were simply not examined.

(3) Applicant referenced issues raised in the prior response relative to (1). In the present action, the Office deemed those arguments to be unpersuasive (*see final* Office action, pp. 3-4), apparently viewing user- (i.e., recipient-) rules applied post delivery to a recipient's mail box as close enough. In this regard, Applicant notes the Office's statement that *Schutzman's* teaching is to be given "the broadest reasonable interpretation" misstates the law.

Based on the telephone conference, Examiner Schmidt agreed that prosecution would be re-opened and that previously unexamined claims would be examined in a next action. Although no agreement was reached respect to any particular claim language, Examiner Schmidt suggested that the present rejections would likely be withdrawn, a further search performed and a

subsequent action (or, if appropriate, allowance) would follow. In view of the progress made during the interview, Applicant indicated that appeal would likely be premature.

Claim Rejections under 35 U.S.C. § 102

Claims 1-17 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent 5,627,764 to Schutzman et al. (hereinafter, "*Schutzman*"). In addition, the Office action purports to reject claims 25-27 and 30-32 over *Schutzman*; however, as discussed in the interview, no grounds for rejection were actually established by the Office. The rejections actually made by the Office are traversed, and with respect to claims 25-27 and 30-32 substantive examination is respectfully requested.

In rejecting claim 1, the Office appears to ignore limitations relative to the sender policy authority, with respect to definitional limitations for "delivery" and even with respect to ordering of operations positively recited in the claim. In particular, while claim 1 specifically recites that the policy applied in response to receipt of package data, is specified by policy data received from a policy authority **of the sender**, rules triggered in *Schutzman* are clearly **recipient-centric** rules. In addition, specific definitional limitations for the claim term "delivery" appear in the text of the claim. **No corresponding delivery** appears in *Schutzman* or the art of record. Finally, even ignoring the specificity with which "delivery" is recited, claim 1 requires that policy determination be made **before such delivery**. Rule evaluation in *Schutzman* clearly follows any act that could be considered delivery.

In rejecting claim 1, the Office attributes teaching to *Schutzman* that cannot be reconciled with the actual disclosure thereof. *Schutzman* discloses system that happens to employ a rule-based mechanism for electronic mail, post-delivery thereof, in work flow management routing, filing decisions, etc. With respect, aside from the uncorrelated usage of somewhat similar terminology, *Schutzman* is not particularly close to the subject matter claimed by Applicant.

Salient differences were highlighted in the prior response (which is incorporated herein by referenced) and therefore, Applicant will not belabor the point(s) already of record. However, since the Office continues to rely upon a rather odd reading of *Schutzman*'s "WHEN READ" event, Applicant re-emphasizes as follows. *Schutzman* discloses a framework in which a rule

may be triggered by a "WHEN READ" event. Since such a rule clearly deals with a situation *after* delivery of a message to a recipient, and indeed, *once the recipient has actually read* the message, *Schutzman* does not disclose or suggest a situation in which delivery is conditioned of on particulars of policy data associated with the sender enterprise.

Finally, in the preceding final action, the Office suggests that "the broadest reasonable interpretation [of] Schutzman [is that it] teaches a situation in which delivery is conditioned on policy data associated with [a] sender enterprise." Respectfully, Applicant must disagree that a person of ordinary skill would so interpret *Schutzman*. However, even more fundamentally, the Office simply misstates the law. The broadest reasonable interpretation standard pertains to *claim construction* and, consistent with Applicant's ability to amend and clarify during prosecution, provides the Office with a basis to broadly interpret claim language. *See generally*, Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 2005); *see also* MPEP 2111. The maxim has nothing at all to do with the scope and content of the prior art, and as applied by the Office to rewrite the actual disclosure of a prior art reference, constitutes **legal error**.

For at least the foregoing reasons, claim 1, together with dependent claims 2-26 which depend therefrom, are all allowable and a notice to that effect is respectfully requested. Though of different scope, independent claims 27 and 30, as well as claims 28-29 and 31-33 which depend therefrom, are also allowable.

Claim Rejections under 35 U.S.C. § 103

Claims 18-19, 21-24, 28, and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Schutzman* in view of US Pat. 6,275,937 to Hailpern et al. ("*Hailpern*"). Each of the § 103 rejections is premised on the errant application of *Schutzman* discussed above. Since *Hailpern* does not disclose or suggest the features missing from *Schutzman*, claims 18-19, 21-24, 28, and 33 are allowable for at least that reason.

Conclusion

In summary, claims 1-38 are in the case. New claims 36-38 have been added. For convenience of the Examiner, previously withdrawn claims 34 and 35 have been **cancelled**.

Remaining claims 1-33 and 36-38 are all believed to be **allowable** over the art of record, and a Notice of Allowance to that effect is respectfully solicited. Nonetheless, if any issues remain that could be more efficiently handled by telephone, the Examiner is requested to call the undersigned at the number listed below.

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David W. O'Brien — 25 Apr 08 (Date)

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